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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,875	02/15/2001	Subbu Srinivasan	CSCO-110932.US.P	4569

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WAGNER, MURABITO & HAO LLP  
Third Floor  
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San Jose, CA 95113

EXAMINER
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MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/784,875

Applicant(s)

SRINIVASAN ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date with this action
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**Affidavit**

I, Katherine W. Mitchell, do hereby affirm the following facts are based on personal experience:

While a project engineer at a previous job, I would obtain project approval for a certain dollar amount. With this approval, I would input specifications so that purchase orders against my project could be issued by purchasing. Oftentimes, a project would be expected to have variables that would change once the project was underway – i.e., asbestos mastic would be found under insulation, flanges expected to be 150 lb forged flanges would be 125 lb cast flanges, equipment that was expected to be sound and safe would be found to need replacement, etc. To allow for these changes to be incorporated in the job without requiring purchasing re-approval, the purchase order would specify the general job specifications, plus a certain amount of "time and material" not to exceed a certain dollar or percentage amount. Thus if a different valve or gasket needed to be substituted for the valve originally specified, this would be covered by the original purchase order and not need re-approval by the purchasing manager, only by the technical engineer/project manager so as not to delay the work, which was often performed 24 hours /day. If the vendor/contractor needed a change authorization off-hours, he would contact the engineer via pager for verbal authorization of the specific change.

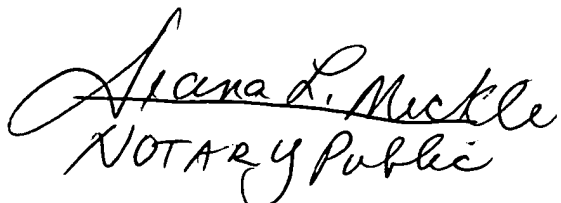
Change orders would be documented by the end of the project and a "corrected" purchase order, including change orders, would be issued to document the final material and scope of the order.



3/7/2005

Katherine W. Mitchell  
Patent Examiner  
AU 3677

*Subscribed and sworn before me this  
7th day of March 2005.*



*Diana L. Muckle*  
NOTARY Public

My Comm. Exps. 9/30 2005

### DETAILED ACTION

1. Claims 28-46 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. The request filed on 12/7/2004 for a Request for Continuing Examination (RCE) under 37 CFR 1.114 is acceptable and an RCE has been established. Any previous finality is hereby withdrawn and a new action on the merits follows. Any newly-submitted claims have been added. An action on the RCE follows.

#### ***Drawings***

3. Six pages of formal drawings have been received and entered.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of maintaining approval after receiving the 2<sup>nd</sup> valid product configuration must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Clarifications***

5. As noted in the attached interview summary, examiner initially considered that the addition of the maintaining acceptance of approval after 2<sup>nd</sup> validation step to be new matter. However, after careful consideration of applicant's verbal arguments that page 19 and the drawings require this step to be included, since no contradictory step is included and something must inevitably occur if the order proceeds, examiner agrees with applicant and is not making the new matter objection. Applicant is correct that the order proceeds, and that no re-approval step is shown on the Figures, and thus it must be assumed that the order proceeds without reapproval. The only mention of the step of maintaining approval after receiving the 2<sup>nd</sup> valid product configuration is on page 19, wherein applicant discloses that it is not always "necessary for the order 200 to go through the customer approval process again." While there is no indication of the conditions that an order does or doesn't go through the reapproval process, and no indication that the 2<sup>nd</sup> approval is determined after receiving the 2<sup>nd</sup> valid product configuration, the absence of such steps necessarily teaches that the approval is maintained. Examiner notes that figures, especially Fig 3B, do not indicate the possibility of re-approval.

pages 5-6 - see Rule 105  
request.

***Rule 105 Request***

6. Examiner notes that applicant has stated that the previously requested information concerning revalidation after delays in order approval; user authentication with passwords, and acceptance of incomplete orders was not readily available.

Different information is now requested since the newly-amended claims include new limitations.

7. The scope of 37 CFR 1.105 is extended to any assignee because the information required may be known to some members of the assignee even if not known by the inventors.

The authority for the Office to make such requirements arises from the statutory requirements of examination pursuant to 35 U.S.C. 131 and 132. An examiner or other Office employee may make a requirement for information reasonably necessary to the examination or treatment of a matter in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports.

Examiner is requesting any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the claimed subject matter has been embodied in. Specifically, "Inside the Cisco Web Site" from Nov/Dec 1997 *Internet Computing Online* (hereafter called *Cisco*) indicates that Cisco's web site had validation and revalidation functions, and referenced (pg 5 of 8) engineers configuring an order and sending the order on to purchasing for approval, and page 2 indicates that saved configurations are reloaded into the

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configurator and revalidated because "things change so quickly, and we may obsolete a certain software that you have today, so that you still need to revalidate each order."


This does not specifically address whether reapproval was required, but indicates this was a known concern of Cisco, the assignee. Therefore, examiner requests any documentation assignee has concerning when:

Order processing/acceptance without re-approval after second validation of configuration **without** being conditioned on the 2<sup>nd</sup> validation occurring within a specific time interval.

Order processing/acceptance without re-approval after second validation of configuration **with** being conditioned on the 2<sup>nd</sup> validation occurring within a specific time interval.

Determining and altering the time interval for accepting approval without requiring reapproval of revalidated configurations

were first available on its website.

  
JJ Swann  
Supervisory Patent Examiner  
Technology Center 3600

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 28-46 are rejected under 35 U.S.C. 103(a) as being anticipated by "Inside the Cisco Web Site", hereafter called Cisco in view of the Examiner's Affidavit of 3/7/2005, hereafter called Affidavit and Bisbee et al. USP 6367013, hereafter called Bisbee.

Re claims 28, 30, 39, 41, 43, and 45: Cisco teaches a computer-implemented method and computer-readable medium and system with means for processing an electronically placed order for customer-configured products (page 2, 2<sup>nd</sup> -4<sup>th</sup> Q/A pairs,) comprising:

- A. Receiving an electronically-placed order for a first valid customer-configured product configuration based on rules that change over time, (pg 5, last Q/A pair), which inherently includes determining if product configuration is valid (pg 2, 3<sup>rd</sup> Q/A pair)
- B. Accepting order approval regardless of whether said order is still valid if less than a pre-determined period of time has expired between order receipt and order approval,
- C. continuing processing order (pg 2, last 4 Q/A pairs, pg 5, last Q/A pair) and determining that said first product configuration is invalid due to rule changes (revalidation inevitably requires that some configurations will be valid and some invalid)



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- D. After said determining, receiving a second valid product configuration that complies with said rules with said changes. (page 2 indicates that saved configurations are reloaded into the configurator and revalidated because "things change so quickly, and we may obsolete a certain software that you have today, so that you still need to revalidate each order)
- E. Maintaining said acceptance of said approval after receiving the second valid product configuration, and continue processing said order (page 4, 2<sup>nd</sup> Q/A pair), without re-approval.

However, Cisco is not explicit at requiring or prohibiting revalidation after a specific step and is not specific that no re-approval is required if within a predetermined time period,. The Cisco reference teaches that revalidation is an option in the process. Repeating the revalidation step, or omitting the revalidation step, at multiple steps in the process, would be obvious variants of a process that teaches that order configurations can be revalidated. Since orders got processed, orders would have to be allowed to proceed prior to expiration of some pre-set time limit, or orders would never proceed. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have omitted or included an extra revalidation step, since it has been held that omission of an element and its function in combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184, and that mere duplication of the essential

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working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Further, the step of allowing a re-validated order after reconfiguration to proceed without further manager approval is known, as documented in examiner's Affidavit. Examiner notes that she worked in cited position from 1986-1995. Since the order proceeded without needing further approval, obviously a time period requiring re-approval had not expired. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have omitted requiring an extra re-approval step, since it has been held that omission of an element and its function in combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184, and that omitting such re-approval is needed when the original order is for goods or services likely to rapidly and/or frequently change from the originally specified parameters, in order to allow orders to proceed without delay. One would have been motivated to make such a combination because re-approval for changes that are technically required would prevent the timely delivery of needed goods and services and add processing costs to the buyer and the seller.

Further Re claims 30, 41, and 45: As discussed above, Cisco in view of the Affidavit teach all the elements except rejecting an order if more than a pre-determined time period has expired between receiving the order and order approval and if the first product configuration is invalid. Bisbee teaches in the abstract that Digital signatures,

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used for electronic approvals, are not valid indefinitely, but expire after a present time-period in order to limit the chances for compromise of the digital signatures

Therefore, It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Cisco in view of Affidavit and further in view of Bisbee to include rejecting an order if more than a pre-determined time period has expired between receiving the order and order approval and if the first product configuration is invalid, in order to ensure that old orders are not processed with obsolete approval authority. One would have been motivated to make such a combination because while it is important to process orders quickly, if no time limit is set to require reapproval, orders could be processed that involve steep increases in price, or that have approval by managers long gone, or for products that are no longer needed.

Re claims 29 and 40 and 44: Per Cisco, Page 5,

*The workflow built into the system enables an engineer to start an order, since they're the technical people and know how to configure the order, and then route it over to the purchasing people in their company, who will then assign the P.O. number and do all of that kind of administrative work.*

*You can attach notes with each routing so everyone can see who's seen it, who's approved it, and who's routed it. You can also enter detailed order notes. The actual notes on the routing are only specific to the company and don't come into Cisco. They go into the database, but are not sent along with the order. But you can also attach order-level notes or line item-level notes that will be sent in to Cisco as part of the actual order.*

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Thus the approval is after the technical person 1<sup>st</sup> configuring the product and before the vendor receiving the order. This would necessarily include the time the first configuration is invalid due to rules changes.

Re claims 31-33, 42 and 46: The time period for expiration of the approval would be selected to coincide with the order processing needs. Altering the parameter would be needed to allow it to coincide with changing production schedules, different customers, and different products.

Re claim 34: Examiner takes Official Notice that order comprise fields with required order processing information, as shown in Cisco page 5 to include P.O. number.

Re claims 35 - 37: Both mutually-exclusive alternatives, covering all possibilities are claimed. Obviously, Cisco must accept approval under at least one of the conditions.

Further Re claim 35: Pages 2 and 4 teach that at least cleanly configured orders are accepted.

Further Re claims 36-37: Absent any criticality, allowing an order to proceed without all the required information, would be an obvious alternative. Note that as taught in page 4 of Cisco, the web-based system actually adds additional order data as needed, so that not all order data is critical in accepting approval. Missing data would inevitably mean that order processing information was checked for validity. Cisco page 4 2<sup>nd</sup> Q/A combination teaches validation from the Web site using the Network Commerce Engine.

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Re claim 38: Cisco in the bottom paragraph of page 3- top of page 4 teaches web-based e-commerce.

***Response to Arguments***

10. Applicant's arguments with respect to claims 28-46 have been considered but are moot in view of the fact that all pending claims were replaced with new claims, and thus a new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited but not used contains more details on the Cisco web-based order configuration and acceptance system as it existed from 1996-2000.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

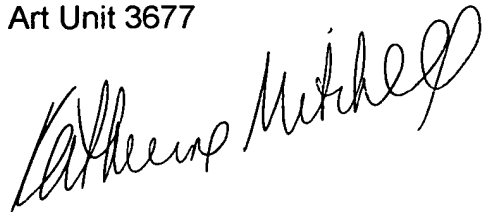
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Note that examiner will have a new phone number after March 31, 2005:  
**(571)272-7069.**

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell  
Examiner  
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A handwritten signature in black ink, appearing to read "Katherine W Mitchell", written in a cursive style.

Kwm  
3/8/2005